

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed December 17, 2003. Claims 1, 11 and 21 are amended for the sake of clarity. Claims 6, 16 and 26 are canceled and new claims 28-39 are added. Claims 1-5, 7-15, 17-26 and 28-39 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 6, 16 and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and claim the subject matter which the Applicant regards as the invention. According to the Examiner, the claim recites determining which consumption rate to use in calculations based upon a comparison of the consumption rate and a threshold value. The Examiner concludes that, because the consumption rate is a function of itself, one of ordinary skill in the art would not be able to determine the results of the comparison.

Applicant respectfully traverses the Examiner's rejection. Definiteness of claim language cannot be analyzed in a vacuum, but must instead be analyzed in light of the disclosure, the teachings of the prior art, and the interpretation that would be given by one possessing ordinary skill in the pertinent art. MPEP § 2173.02. A procedure for making the comparison and determining the power usage which the Examiner says could not be carried out by one of ordinary skill in the art is in fact illustrated generally in Figure 4A and with a specific example in Figure 4B, and is described in the text associated with these figures between page 8, line 12 to page 10, line 4. In view of this explanation in the specification and drawings, Applicant submits that these claims, when viewed in light of the disclosure, are entirely definite and respectfully requests withdrawal of the rejections.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-3, 5-13, 15-23 and 25-27 under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent Application Publication No. 2002/0066045 to Layton et al ("Layton"). Further, the Examiner rejected claims 4, 14 and 24 as obvious in view of, and therefore unpatentable over, Layton in view of McPherson, "An

Introduction to Electrical Machines and Transformers," ISBN 0-471-05586-7, 1981 ("McPherson").

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As further explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 1, as amended, recites a process combination including "determining the number and type of each of a plurality of components comprising a device," "determining a component power consumption for each of the plurality of components," and "determining a device power consumption prior to installation or operation of the device by summing the component power consumptions of all of the plurality of components." The Examiner concedes that Layton does not disclose a combination including "determining the number and type of each of a plurality of components comprising a device" and "determining a component power consumption for each of the plurality of components," but nonetheless argues that Layton obviates claim 1. Applicant disagrees. By conceding that the Layton does not disclose every element and limitation of the claim, the Examiner has essentially conceded that at least one of the requirements of the *prima facie* case has been met, and there is therefore no *prima facie* case of obviousness.

If the Examiner is attempting to argue that the elements he concedes are not disclosed in Layton are inherently disclosed, that argument fails as well. To rely on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. MPEP § 2112. This the Examiner has not done, and cannot do. Layton teaches only that the overall power consumption of a device can be measured with instrumentation after the device is operating; there is no disclosure, teaching or suggestion that the power of the device could or should be determined prior to its installation or operation, and there is no disclosure, teaching or suggestion of determining the power consumption of individual components. Layton therefore provides no disclosure, teaching or suggestion of "determining a component power consumption for each of the plurality of components" or "determining a device power

consumption prior to installation or operation of the device by summing the component power consumptions of all of the plurality of components.”

Finally, the Examiner cites *Nerwin v. Erlichman*, 168 U.S.P.Q. 177, 179 (Bd. Pat. App. & Inter. 1969), and attempts to argue that the claimed combination is simply a separation of what is shown as integral in Layton. But that cannot be: for Layton to be an integral version of the claimed invention would require at least that Layton be able to perform the claimed process combination. As discussed above, Layton does not disclose, teach or suggest every element of the claim and is incapable of performing the recited process combination. For these reasons, Applicant submits that claim 1 is in condition for allowance and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 2-5 and 7-10, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant therefore respectfully submits that claims 2-5 and 7-10 are allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 11 recites an article of manufacture comprising a machine-readable medium having instructions stored thereon to “determine the number and type of each of a plurality of components comprising a device,” “determine a component power consumption for each of the plurality of components,” and “determine a device power consumption prior to installation or operation of the device by summing the component power consumptions of all of the plurality of components.” As discussed above in connection with claim 1, Layton cannot obviate a combination including these limitations. Applicant therefore respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 12-15 and 17-20, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 11 is in condition for allowance. Applicant therefore respectfully submits that claims 12-15 and 17-20 are allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the

features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 21, as amended, recites a system comprising a plurality of devices installed in a rack, wherein each device comprises a plurality of components wherein the capacities of a power supply and a cooling unit are determined by “determining the number and type of each of the plurality of components comprising each of the plurality of devices,” “determining a component power consumption for each of the plurality of components,” “determining a device power consumption for each device prior to installation or operation by summing the component power consumptions of all of the plurality of components,” and “determining a rack power consumption by summing the device power consumptions for all of the plurality of devices.” As discussed above in connection with claim 1, Layton cannot obviate a combination including these limitations. Applicant therefore respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 22-25 and 27, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 21 is in condition for allowance. Applicant therefore respectfully submits that claims 22-25 and 27 are allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Allowable Claims

In paragraph 5 of the Office Action, the Examiner concedes that the prior art of record neither discloses nor suggests that one should selectively consider the actual or maximum power consumption based upon a comparison of a known power consumption value of the device with a threshold value. Applicant’s legal representative understands this statement to mean that the Examiner believes claims 6, 16 and 26 would be allowable if amended to overcome the rejections under 35 U.S.C. § 112, second paragraph.

New claim 28 combines limitations substantially like those previously found in claim 6 with those of claim 1, from which claim 6 depended. As discussed above, the limitations found in former claim 6 are not indefinite, and Applicant submits that new claim 28 is therefore

allowable. As to new claims 29-32, if an independent claim is allowable then all claims depending therefrom are also allowable. Applicant submits that claims 29-32 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests allowance of claims 28-32.

New claim 33 combines limitations substantially like those previously found in claim 16 with those of claim 11, from which claim 16 depended. As discussed above, the limitations found in former claim 16 are not indefinite, and Applicant submits that new claim 33 is therefore allowable. As to new claims 34-37, if an independent claim is allowable then all claims depending therefrom are also allowable. Applicant submits that claims 34-37 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests allowance of claims 33-37.

New claim 38 combines limitations substantially like those previously found in claim 26 with those of claim 21, from which claim 26 depended. As discussed above, the limitations found in former claim 26 are not indefinite, and Applicant submits that new claim 38 is therefore allowable. As to new claim 39, if an independent claim is allowable then all claims depending therefrom are also allowable. Applicant submits that claim 39 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests allowance of claims 38-39.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 3-17-04

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